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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,463	11/12/2003	Judith Schwabe	P-4181CIP	9131
24209 7590 08/10/2007 GUNNISON MCKAY & HODGSON, LLP 1900 GARDEN ROAD SUITE 220 MONTEREY, CA 93940			EXAMINER VU, TUAN A	
			ART UNIT 2193	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/712,463	Applicant(s) SCHWABE ET AL.	
	Examiner Tuan A. Vu	Art Unit 2193	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-78.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11: does NOT place the application in condition for allowance because: As per the argument that as disclosed, (e.g. unoptimized larger size instructions are optimized into smaller base instructions), extensive support in the Specifications is evidence to overcome Examiner's Objection to the language, it is noted that the claim should suffice to enable one of ordinary skill in the art to construe the invention; and the phrase 'optimizing to a second instruction' although understandable via scanning the Specs still bears improper English construct leading to more than one interpretation, and this interpretation does not have to read the Specifications (emphasis added) into the claim; the language objection will stand. Besides, the term 'optimizing' without further implementation details is bordering on what is termed as 'preemptive' type of claim language, subject to statutory type of impropriety. As for the double patenting, the teachings from '581 claim 12 in view of the teachings conveyed from instant claims 17-18 amount to equivalence in claimed subject matter at least in terms of suggested teachings; and based on inherent teaching conveyed from '581 claim 12, the rationale of the DP has been founded to render obvious instant claim 18, and the argument about '581 claim 1 not suggesting 'validating' would be not commensurate with the specifics of the rationale of the Office Action. Thus, the argument is not persuasive. The argument against '581 claim 53 not suggesting 'validating' and that claim language alone not gist should be analyzed to establish DP rejection will not suffice to overcome the very grounds of rejection notably in light of the in-depth analysis thereof as set forth in the Office Action. The gist in question, it is noted, comes from the language of the claim, and as long as it stems from this language, the so-called gist will take effect, for the ground of obviousness is permitted to include not only explicit teachings but also to take under consideration one of ordinary skill in the art level of interpretation, grasp of the pertinent field, and any inherent teachings at the time the invention was reduced to practice. The argument fails to show how and why it would not be obvious to modify '581 to provide the teachings as claimed in the instant claims. For the 103 rejection, Applicants have submitted the Examiner's stand contradicts not only with Yellin, but also with the very construct of claim 1, for example, as to start with a 1st instruction then generate a 2nd instruction; i.e. ignoring thereby the plain meaning of the claim. The claim language is objected as improper and this is not giving the claim a paradigm of 2 instructions (by which the second is generated from a first) with all the weight derived from the Specifications, i.e. notwithstanding broad interpretation given to said claimed second instruction of a different type and smaller in size than the first. The argument that Yellin is not providing teachings as required by claim 1 would not be deemed sufficient to preclude a similar teaching by Yellin's; i.e. an optimization approach of replacement using a second successor instruction/operand to alleviate an overflow therein based on analysis of first type of operand. Besides, the argument does not seem to overcome obviousness in taking under consideration combined teachings but contends with attacking one reference; and the corresponding argument turning against the secondary reference is deemed not meeting a proper prima facie case of rebut, i.e. a mere allegation of patentability without pointing how the second reference when combined w/ Yellin would not meet the totality of the claim. The Applicant's submission in whole amounts to non-convincing arguments and the claims will stand not in condition for allowance.



8-06-07